

REMARKS

The present application includes claims 1-39 pending. In the First Office Action, claims 1-28 and 34-39 were rejected. Claims 29-33 were withdrawn as being directed to nonelected invention. In this response, claims 1, 11, 22, 28, 34, and 39 have been amended, and claims 29-33 have been cancelled without prejudice to pursuit in a divisional application. Reconsideration of the present application including claims 1-28 and 34-39 is respectfully requested.

In the Office Action, it was indicated that claims 1-39 were rejected under 35 USC §112, second paragraph for being indefinite for omitting necessary structural connections. In particular, it was asserted that claim required insertion of "configured to extend" after body portion in lines 3 and 5 to avoid positively reciting the upper and lower vertebrae in combination with the implant. Claim 1 has been amended in this response as suggested by the Examiner. However, with regard to the other claims 11-28 and 34-39, it does not appear that there is any positive recitation of the upper and lower vertebrae in combination with the implant. Accordingly, it is believed that the 35 USC §112, second paragraph was intended to apply to claims 1-10, and the remaining claim 11-39 (including the withdrawn claims 29-33) were not intended to be rejected under 35 USC §112, second paragraph. If this is incorrect, then Applicant respectfully requests clarification of the basis for any 35 USC §112, second paragraph rejection of claims 11-28 and 34-39.

The drawings were objected to because the reference sign "90" is not mentioned in the description. Enclosed herewith under cover of separate letter is a proposed drawing change in which reference sign "90" is removed.

Claims 11, 22 and 34 have been amended to clarify the positioning of the upper and lower members relative to the body portion. Such amendments are not presented for reasons related to patentability of these claims, but rather to improve form and readability of these claims. Claims 28 and 39 have been amended so that the preamble of each is consistent with the preamble of the claim from which it depends.

STATEMENT OF COMMON OWNERSHIP

Claims 1-28 and 34-39 were rejected under 35 USC §103(a) over U. S. Patent No. 4,892,545 to Day et al. in view of U.S. Patent No. 6,206,923 to Boyd et al. Under 35 U.S.C. §103(c), references which would qualify as prior art under 35 U.S.C. §102(e) would not be prior art for applications filed on or after November 29, 1999, if the subject matter disclosed in the reference and the claimed invention were commonly owned at the time the invention was made.

The present application has a filing date of February 6, 2001, and is thus subject to the provisions of 35 U.S.C.103(c) that are effective November 29, 1999. The '923 patent to Boyd has a filing date of January 8, 1999, and issued on March 27, 2001, after the filing date of the present application. Thus, the '923 patent could potentially qualify as prior art under 35 U.S.C. §102(e). However, the invention claimed in the present application and U.S. Patent No. 6,206,923 were, at the time the claimed invention was made, owned by, or subject to an obligation of assignment to, the same person.

Submitted herewith are copies of the assignment records indicating that the '923 patent and the present application have been assigned to a common owner, SDGI Holdings, Inc.

Accordingly, the '923 patent is not prior art to the present application, and withdrawal of the obviousness rejection of claims 1-28 and 34-39 in view of the combination the '545 and '923 patents is respectfully requested.

Attached hereto are pages numbered 7-8 captioned "**VERSION WITH MARKINGS TO SHOW CHANGES MADE**" which present a marked up version of the changes made to this application by the current amendment and. In view of the foregoing remarks, reconsideration of the present application as amended is respectfully requested. Action towards a Notice of Allowance for this application, including claims 1-28 and 34-39 is hereby solicited. The undersigned would welcome an interview with the Examiner to resolve any outstanding issues with respect to the present application.

Respectfully submitted

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claims 29-33 have been cancelled in this response.

Please replace claims 1, 11, 22, 28, 34, and 39 with the following amended claims:

1. (Amended) An implant, comprising:
 - a body portion positionable in the disc space between adjacent upper and lower vertebrae;
 - an upper member extending from said body portion and configured to extend along the body of said upper vertebra; and
 - a lower member extending from said body portion and configured to extend along the body of said lower vertebra, wherein said body portion, said upper member, and said lower member are each made from bone material.
 11. (Amended) An implant, comprising:
 - a bone body extending between a first bearing surface and a second bearing surface; and
 - an upper bone member extending from said body in a first direction and a lower bone member extending from said body in a second direction opposite said first direction, wherein said upper and lower bone members are at least partially demineralized and are configured to extend along an upper vertebral body and a lower vertebral body, respectively, when said bone body is positioned in a space between the upper vertebral body and the lower vertebral body.
 22. (Amended) A method of preparing a bone implant, comprising:
 - providing a rigid bone segment having a body portion with an upper bearing surface and an opposite lower bearing surface, said rigid bone segment further including

an upper flange member and an opposite lower flange member each extending from said body portion; and

at least partially demineralizing the upper and lower flange members to create a flexible upper flange member and a flexible lower flange member extending from the rigid body portion, wherein said upper and lower flange members are configured to extend along an upper vertebral body and a lower vertebral body, respectively, when said body portion is positioned in a space between the upper vertebral body and the lower vertebral body.

28. (Amended) The [implant] method of claim 22, wherein the implant is formed from a single segment of bone.

34. (Amended) A method of preparing a bone implant, comprising:
obtaining a rigid bone segment; and
forming from said rigid bone segment an implant having a body portion with an upper bearing surface and opposite lower bearing surface, said rigid bone segment further including an upper flange member and an opposite lower flange member each extending from said body portion, wherein said upper and lower flange members are configured to extend along an upper vertebral body and a lower vertebral body, respectively, when said body portion is positioned in a space between the upper vertebral body and the lower vertebral body.

39. (Amended) The [implant] method of claim 34, wherein the implant is formed from a single segment of bone.